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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,958	06/22/2001	Kazuyuki Yokogawa	914-133	7078

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EXAMINER

KIM, NICHOLAS J

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/885,958	<b>Applicant(s)</b> YOKOGAWA, KAZUYUKI	
	<b>Examiner</b> Nicholas Kim	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>(see attached)</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

IDSs: 22 June 2001, 08 Oct 2003, 13 Sept 2004

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The Supplemental Information Disclosure Statements (IDSs) submitted on 8 October 2003 and 13 September 2004, were filed after the mailing date of the utility application on 22 June 2001. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the IDSs are being considered by the examiner.

### ***Claim Objections***

2. Claims 1, 5-8, 11, 15-18, 21, 25-28, 31, and 35-38 are objected to because of informalities. For the sake of brevity and in light of the parallel correspondence among Applicant's four groups of Claims, the objections set forth below highlight informalities in Claims 21-30 that are also present in the corresponding Claims 1-20 and 31-40. In Claims 21 and 25-28, the comma in the last limitation before "to the client computer used by said" should be deleted. In Claim 25, "characters being changeable in figures" at line 4 should read "characters each being changeable in figure." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Again, for the sake of brevity and in light of the parallel correspondence among

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Applicant's four groups of Claims, the rejections set forth below highlight indefiniteness issues in Claims 21-30 that are also present in corresponding Claims 1-20 and 31-40.

5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Appropriate correction is required.

6. For instance, Claim 21 recites the limitation "the data" at line 11 and "the user" at line 12. It is unclear to which previous recitation of data or user these term respectively refer. Claim 26 recites "a user" at lines 5 and 7. It is unclear to which of the previously recited users these terms refer.

7. More generally, Claims 23 and 25-28 each recite a final limitation spanning at least six lines (Claim 23: "sending..."; Claim 25: "said step of sending..."; Claim 26: "said step of sending..."; Claim 27: "said step of sending..."; and Claim 28: "said step of sending...").

Especially in these claims, it is unclear which terms are meant to be included for the purpose of antecedent basis and which terms are meant to further limit the claims. For instance, in the case of Claim 26, the meaning and scope of **"said step of sending the data representing the virtual character includes the step, when the user selected in said step of selecting the user is the user identified in said step of identifying the user, of sending the data representing the virtual character having its figure changed based on the history of services provided to said selected user and the data for implementation of said motion prepared in said step of preparing the data for implementation of the motion to the client computer used by said selected user"** [emphasis added] is confusing because it is unclear whether the terms in **bold** are meant to be new limitations or are referring to previous steps and limitations. Additionally,

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within the same example, the Claim recites “the user selected in said step of selecting,” and “said selected user.” For the purpose of examination, the terms in bold are interpreted as attempts to preserve antecedent basis (as opposed to unique limitations), and instances inverted limitations (the user selected, selected user) are interpreted to be equivalent.

### ***Double Patenting***

8. Applicant is advised that should Claims 1-10 be found allowable, Claims 11-20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Although Claims 11-20 recite “means for” limitations, these Claims are not interpreted invoke interpretation under 35 U.S.C. 112, sixth paragraph since the “means for” phrases are modified by sufficient structure or acts for achieving the specified functions to preclude a means-plus-function interpretation. See Part (C) of the three-prong analysis at MPEP § 2181(I). Therefore, Claims 11-20 recite limitations corresponding substantially in scope to those recited in Claims 1-10. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3-8, 10, 11, 13-18, 20, 21, 23-28, 30, 31, 33-38, and 40 are rejected under 35

U.S.C. 102(a)/(e) as anticipated by Kiraly et al. (U.S. Patent No. 6,088,731, herein "Kiraly").

11. Beginning with Claims 1, 11, 21, and 31, Kiraly teaches identifying a user using the client computer based on data received from the client computer (FIGURE 11 and Col. 12, l. 39 – Col. 13, l. 36, user visits web site and authorization phase), providing the user with a service according to a request from the user (Col. 2, l. 64 – Col. 3, l. 4 and Col. 13, l. 44-47), storing a history of services provided to the user (Col. 2, l. 64 – Col. 3, l. 4 and Col. 5, l. 57 – Col. 6 – l. 5), preparing data representing the virtual character changeable in figure based on the history of services provided, and sending the data representing the virtual character having its figure changed based on the history of services provided to the user identified in the step of identifying the user (Col. 5, l. 63-67, "information thus detected and collected is presented to the user... by way of changing the shape..."), to the client computer (computer system 112) used by the identified user.

12. With regard to the step of identifying, it is noted that a user visiting a web site inherently requires data to be sent from the client and for the web site data to be routed specifically to the user, thereby identifying the user. Kiraly's authorization phase further identifies the user by restricting services to only certain web sites authorized to operate with the particular user's intelligent agent. With regard to the step of providing the user with a service, in addition to providing regular web site data to a user (browsing), Kiraly also teaches the service of presenting

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“information of interest” to a user. In Kiraly, the intelligent agent’s growing or altered knowledge base (from detecting, collecting, and presenting a user “information of interest”) corresponds to Applicant’s history of services as the user visits desired web sites.

13. Turning to Claims 3, 13, 23, and 33, Kiraly further discloses determining a data format with which the client computer is able to output (Col. 10, l. 44 – Col. 12, l. 38, HTTP/HTML, MIME formats for communicating data), wherein the step of sending the data representing the virtual character includes the step of transforming the data representing the virtual character having its figure changed based on the history of services provided to the user identified in the step of identifying the user to the data format determined in the step of determining the data format (Col. 11, l. 37-39, “MIME encodes... and decodes...”), to send to the client computer used by the identified user.

14. Addressing now Claims 4, 14, 24, and 34, Kiraly describes that the step of providing the service includes the step of providing information to the user according to a request from the user (Col. 2, l. 64 – Col. 3, l. 4 and Col. 13, l. 44-47, “information of interest”), the step of storing the history of services provided includes the step of storing the history of services provided to the user after classifying the services within the history into categories (Col. 13, l. 66 – Col. 14, l. 56, “an advisor on a variety of subjects”), and the method further including the step of generating and storing preference information of the user based on the history with the services classified into the categories (Col. 5, l. 57 – Col. 6, l. 5 and Col. 14, l. 8, “knowledge base” of the intelligent agent). With regard to the categorization of a history of services, it is noted that the intelligent agent’s ability to act as an advisor on a variety of subjects inherently requires such categorization. Additionally, Applicant’s user preference information is taught by Kiraly since



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the intelligent agent's knowledge and capabilities follow directly from the voluntary browsing activity (and therefore, preferences) of the user.

15. Kiraly also teaches all limitations recited by Applicant's Claims 5, 15, 25, and 35, including that the step of preparing the data representing the virtual character includes the step of preparing data including a plurality of virtual characters (FIGURE 3 and Col. 15, ℓ. 52 – Col. 16, ℓ. 4, default parrot and giraffe), that the plurality of virtual characters being changeable in figures based on the history of services provided (see rejection of Claims 1, 11, 21, and 31 above), the virtual character sending method further including the step of selecting one of the plurality of virtual characters based on the user preference information (Col. 15, ℓ. 52 – Col. 16, ℓ. 4, where user preference information is addressed above), and that the step of sending the data representing the virtual character includes the step of sending the data representing the virtual character selected in the step of selecting one of the virtual characters having its figure changed based on the history of services provided to the user identified in the step of identifying the user (Col. 15, ℓ. 52 – Col. 16, ℓ. 4, assistant changes to giraffe from default parrot), to the client computer used by the identified user. Concerning the step of selecting one of the plurality of virtual characters, it is noted that the user arriving at a toy web site teaches preference information according to which giraffe images are selected and sent to the client computer.

16. Moving now to Claims 7, 17, 27, and 37, Kiraly teaches preparing data for implementation of a motion of the virtual character in the client computer, the motion being for prompting a user to access advertisement information (Col. 14, ℓ. 8-30), and selecting a user based on the preference information stored in the step of storing the preference information and a content of the advertisement information (Col. 14, ℓ. 8-30), wherein the step of sending the data

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representing the virtual character includes the step, when the user selected in the step of selecting the user is the user identified in the step of identifying the user, of sending the data representing the virtual character having its figure changed based on the history of services provided to the selected user and the data for implementation of the motion prepared in the step of preparing the data for implementation of the motion (FIGURE 11 and Col. 12, ℓ. 39 – Col. 13, ℓ. 36), to the client computer used by the selected user. Here, selection of a user is similar to the case of identifying a user (discussed above). In particular, a user is selected as a recipient or benefactor of the intelligent agent's activities by the user's own browsing activity/preferences (visiting an auto repair or toy company web site).

17. Addressing Claims 8, 18, 28, and 38, Kiraly also discloses preparing data for implementation of a motion of the virtual character in the client computer (Col. 5, ℓ. 67, “changing shape and movements...”), wherein the step of sending the data representing the virtual character includes the step of sending the data representing the virtual character having its figure changed based on the history of services provided to the user identified in the step of identifying the user and the data for implementation of the motion prepared in the step of preparing the data for implementation of the motion (FIGURE 11 and Col. 12, ℓ. 39 – Col. 13, ℓ. 36), to the client computer used by the identified user.

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2, 9, 12, 19, 22, 29, 32, and 39 are rejected under 35 U.S.C. 103(a) as unpatentable over Kiraly in view of Matsuda et al. (U.S. Patent No. 6,253,167, herein “Matsuda”).

20. Although Kiraly provides actions corresponding to the history of services provided to the user, Kiraly does not explicitly teach each of the limitations recited in the noted Claims.

However, Matsuda expressly teaches that the step of storing the history of services includes the step of storing the history of services provided to the user as history points that are calculated by adding up points prescribed for each kind of the services (Matsuda at Col. 11, ℓ. 15 – Col. 12, ℓ. 18, “growth parameter control table,” “health index,” “physique index”), that the virtual character is changeable in figure based on the history points (Matsuda at FIGs. 13, 15 and Col. 12, ℓ. 6-10), and that the motion to be implemented in the client computer is determined according to the history points (Matsuda at Col. 12, ℓ. 19-28). In Matsuda, the history of services is reflected in the growth of the virtual pet as the user frequents the web site, where services in Matsuda are generally the provision of an online virtual pet for users. Furthermore, it would have been obvious to one skilled in the art at the time of Applicants’ invention to modify Kiraly to incorporate and appropriately incorporate motion according to the incremented parameters and indices as taught by Matsuda for advantageously expressing more realistic motion to a user (Matsuda at Col. 3, ℓ. 26-27).

21. Claims 6, 10, 16, 20, 26, 30, 36, and 40 are rejected under 35 U.S.C. 103(a) as unpatentable over Kiraly in view of Plantec et al. (U.S. Patent No. 6,826,540, herein “Plantec”).

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22. As discussed above, Kiraly discloses preparing data for implementation of a motion of the virtual character in the client computer (Kiraly at Col. 5, ℓ. 67, “changing the shape and movements...” ) wherein the step of sending the data representing the virtual character includes the step, when the user selected in the step of selecting the user is the user identified in the step of identifying the user, of sending the data representing the virtual character having its figure changed based on the history of services provided to the selected user and the data for implementation of the motion prepared in the step of preparing the data for implementation of the motion, to the client computer used by the selected user (Kiraly at FIGURE 11 and Col. 12, ℓ. 39 – Col. 13, ℓ. 36), and selecting a user based on the preference information stored in the step of storing the preference information (Kiraly at Col. 14, ℓ. 8-30). Also, it is noted that the communication and command input of Kiraly teaches a questionnaire (Kiraly at FIGURES 3, 4, and 5C). However, Kiraly does not explicitly teach the other limitations recited in the noted Claims. Plantec expressly teaches motion for displaying a questionnaire to a user at the client computer and for sending an answer to the questionnaire input by the user back to the server computer (Plantec at Abstract), and selecting a user based on a content of the questionnaire (Plantec at Col. 26, ℓ. 11-13, “adapting to a user’s interests during a survey”). Furthermore, it would have been obvious to one skilled in the art at the time of Applicants’ invention to modify Kiraly to incorporate the questionnaire motion and questionnaire input as taught by Plantec for advantageously making the survey process more natural, pleasant, and enjoyable (Plantec at Col. 20, ℓ. 55-56).

### ***Conclusion***

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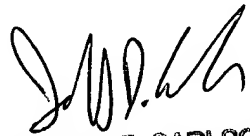
23. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure. Merrick et al. (U.S. Patent No. 6,433,784) describes animated characters for use on the Internet including a mascot pointing to specific items on a page. Hayes-Roth (U.S. Patent Pub. No. 2002/0005865) discloses computer-controlled Web Guide agent that can interact and learn from a user by storing data in a "User Profile" database. Segan et al. (U.S. Patent Pub. No. 2002/0029252) describes a browsing system employing a character icon to browse content, the character icon capable of being changed or enhanced.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Kim whose telephone number is (571) 272-1392. The examiner can normally be reached on Monday - Friday 8am - 4:30pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJK

  
JEFFREY D. CARLSON  
PRIMARY EXAMINER